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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,077	10/17/2001	Kevin Ronald Franklin	J3568(C)	7270

201 7590 12/24/2003

UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 12/24/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,077

Applicant(s)

FRANKLIN ET AL.

Examiner

EVERETT WHITE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 28-30, 37-50 and 52-54 is/are rejected.
- 7) ☒ Claim(s) 22-27, 31-36 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. The amendment filed September 22, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claim 51 has been canceled.
 - (B) New Claims 52-55 have been added.
 - (C) Claims 1, 18, 19, 21, 24, 29, 32, 33, 40, 43-45, 47 and 48 have been amended.
 - (D) Comments regarding Office Action have been provided drawn to:
 - (a) 112, 2nd paragraph rejection, which has been withdrawn;
 - (b) Statutory double patenting rejection, which has been maintained;
 - (c) 102(b) rejection, which has been withdrawn.
2. Claims 1-50 and 52-55 are pending in the case.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting - Statutory

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 28-30, 32, 37-46 and 50 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 1-10, 15, 21, 23-27 and 33 of prior U.S. Patent No. 6,248,312. This is a double patenting rejection.

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7. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the present invention is not drawn to identical subject matter as is claimed in US Patent No. 6,248,312 because it is required that Z differs from X, such that Z is never the same as X in any molecule. U.S. Patent No. 6,248,312 ('312) discloses the structure of β -cellobiose heptanonanoate in Example 9 (see column 29, line 25) which is representative of the acylated cellobiose compounds that may be a component of the compositions thereof which is analogous to the acylated cellobiose compound set forth in instant Claim 28 since the position in the β - cellobiose heptanonanoate in the '312 patent which is identical to the Z position of the instant Claims is represented as H wherein the identical X positions are represented as -OCR groups. Hence, the '312 patent does include acylated cellobiose compounds wherein the Z group is different from the X group of a acylated cellobiose compound. Accordingly, the rejection of the claims under 35 U.S.C. 101 is maintained.

8. Claims 1-12, 15, 16, 18, 20, 28, and 52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 1-5, 9-15 and 18-22 of prior U.S. Patent No. 6,458,344. This is a double patenting rejection.

Applicants claim an acylated cellobiose and compositions thereof wherein the acylated cellobiose satisfies the formula set forth in instant Claim 1 in which X represents an acyl group R-CO- or H, Z represents an acyl group R'-CO- or H and not more than a minority of R + R' residues represent H and in the remaining R + R' residues, R represents a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 5 to 31 carbon atoms and R' represents a residue, which is different from R and which is: (i) a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 1 to 31 carbon atoms optionally substituted or (ii) an aromatic hydrocarbon residue, optionally substituted or (iii) a cycloaliphatic hydrocarbon, optionally substituted. Additional limitations in the dependent claims include specific R and R' groups and a major fraction of the acylated cellobiose being the α -anomer.

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U.S. Patent No. 6,458,344 (Franklin et al patent) sets forth claims directed to a partially esterified cellobiose containing at least two glucose residues joined in β -1,4-configuration having the formula set forth in Claim 18 thereof, wherein each Z is independently hydrogen or an acyl groups of the formula RCO- where R denotes a hydrocarbonyl group containing from 7-11 carbon atoms, with the proviso that not more than half of the Z groups are hydrogen at least 80% of esterified cellobiose is fully esterified and (b) at least 80% of the esterified cellobiose is present as the α -anomer. See the structure of the compound β -cellobiose hepta-nonanoate in column 31, line 15 of the Franklin et al patent, which is representative of the partially esterified cellobiose set forth in the claims of the Franklin et al patent and meet the requirement set forth for the acylated cellobiose in the instant claims by setting forth an -OH group at the -OZ locations of the instant claims. An -OCR' group is not present in the formula and therefore the requirement in the instant claims that R' represents a residue which is different from R is met.

9. Applicant's arguments with respect to Claims 1-12, 15, 16, 18, 20, 28, and 52 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting - Nonstatutory

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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11. Claims 13, 14, 17, 19, 21, 29-30, 37-50, 53 and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5, 9-15 and 18-22 of U.S. Patent No. 6,458,344. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason.

Applicants claim an acylated cellobiose and compositions thereof wherein the acylated cellobiose satisfies the formula set forth in instant Claim 1 in which X represents an acyl group R-CO- or H, Z represents an acyl group R'-CO- or H and not more than a minority of R + R' residues represent H and in the remaining R + R' residues, R represents a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 5 to 31 carbon atoms and R' represents a residue which is different from R and which is: (i) a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 1 to 31 carbon atoms optionally substituted or (ii) an aromatic hydrocarbon residue, optionally substituted or (iii) a cycloaliphatic hydrocarbon, optionally substituted. Additional limitations in the dependent claims include specific R and R' groups and major fractions of the acylated cellobiose being the α -anomer or the β -anomer.

U.S. Patent No. 6,458,344 (Franklin et al patent) sets forth claims directed to a partially esterified cellobiose containing at least two glucose residues joined in β -1,4-configuration having the formula set forth in Claim 18 thereof, wherein each Z is independently hydrogen or an acyl group of the formula RCO- where R denotes a hydrocarbyl group containing from 7-11 carbon atoms, with the proviso that not more than half of the Z groups are hydrogen at least 80% of esterified cellobiose is fully esterified and (b) at least 80% of the esterified cellobiose is present as the α -anomer. See the structure of the compound β -cellobiose hepta-nonanoate in column 31, line 15 of the Franklin et al patent, which meet the requirement set forth for the acylated cellobiose in the instant claims by setting forth an -OH group at the -OZ locations of the instant claims. An -OCR' group is not present in the formula and therefore the requirement in the instant claims that R' represents a residue which is different from R is met. Accordingly, it would have been obvious to one of ordinary skill in the art at the

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time of Applicants invention having the Franklin et al patent before him to replace the –OCR' group with an –OH group in view of their closely related structures and the resulting expectation of similar cosmetic properties.

12. Applicant's arguments with respect to Claims 13, 14, 17, 19, 21, 29-30, 37-50, 53 and 54 have been considered but are moot in view of the new ground(s) of rejection.

Claims Objected To

13. Claims 22-27, 31-36 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary

14. Claims 1-21, 28-30, 37-50 and 52-54 are rejected; Claims 22-27, 31-36 and 55 are objected.

Examiner's Telephone Number, Fax Number, and Other Information

15. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

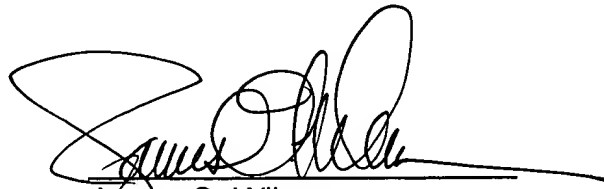
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.


E. White


James O. Wilson
Supervisory Primary Examiner
Technology Center 1600